

# Notice of Allowability

Application No.

10/785,271

Examiner

Marina Lamm

Applicant(s)

BONDA, CRAIG A.

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1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to declaration and arguments filed 9/24/04.
2. ☒ The allowed claim(s) is/are 1-32.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☐ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

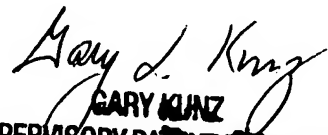
\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 7/19/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

  
**GARY KINZ**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600  
Part of Paper No./Mail Date 010405

### **EXAMINER'S AMENDMENT**

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Anderson on 01/04/05.

The application has been amended as follows:

Replace Claim 16 with amended Claim 16 below:

Claim 16 (amended). The composition of claim 1, further comprising a photoactive compound selected from the group consisting of p-aminobenzoic acid and salts and derivatives thereof; anthranilate and derivatives thereof; dibenzoylmethane and derivatives thereof; salicylate and derivatives thereof; cinnamic acid and derivatives thereof; dihydroxycinnamic acid and derivatives thereof; camphor and salts and derivatives thereof; trihydroxycinnamic acid and derivatives thereof; dibenzalacetone naphtholsulfonate and salts and derivatives thereof; benzalacetophenone naphtholsulfonate and salts thereof; dihydroxy-naphthoic acid and salts thereof; o-hydroxydiphenyldisulfonate and salts thereof; p-hydroxydiphenyldisulfonate and salts thereof; coumarin and derivatives thereof; diazole derivatives; quinine and salts thereof; quinoline derivatives; hydroxy-substituted benzophenone derivatives; methoxy-substituted benzophenone derivatives; tannic acid; hydroquinone; benzophenone

derivatives; 1,3,5-triazine derivatives, phenyldibenzimidazole tetrasulfonate and salts and derivatives thereof; terephthalylidene dicamphor sulfonic acid and salts and derivatives thereof; methylene bis-benzotriazolyl tetramethylbutylphenol and salts and derivatives thereof; bis-ethylhexyloxyphenol methoxyphenyl triazine and salts and derivatives thereof; diethylamino hydroxybenzoyl hexyl benzoate and salts and derivatives thereof; and combinations of the foregoing.

***Terminal Disclaimer***

2. The terminal disclaimer filed on 9/24/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of a patent granted on SN 10/361.223 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Allowable Subject Matter***

3. Claims 1-32 are allowed.

4. The following is an examiner's statement of reasons for allowance: The claims are allowable over the cited prior art because the prior art does not teach, disclose nor make obvious the claimed combination of a dibenzoylmethane derivative, with (a) an  $\alpha$ -cyano- $\beta,\beta$ -diphenylacrylate compound, and (b) a diester or polyester of naphthalene dicarboxylic acid of the given formula; wherein the weight ratio of (a)/(b) is at least 0.95. The closest available prior art (Gers-Barlag et al., US 6,491,901 or US 2001/0022966, both of record) disclosed the claimed combination of compounds but fails to teach the claimed ratio of (a)/(b) of at least 0.95. The maximum disclosed

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(a)/(b) ration in the Gers-Barlag reference is 0.72. The declaration of Craig A. Bonda under 37 CFR 1.132 filed 9/24/04 compares the claimed composition with that of the Gers-Barlag et al. reference and shows unexpected results (i.e. no loss of UVA or UVB absorbance) attributable to the claimed ratio. Therefore, the declaration is sufficient to overcome the Gers-Barlag reference. Further, Bonda et al. (US 5,993,789) teach dibenzoylmethane derivatives in combination with either (a) an  $\alpha$ -cyano- $\beta,\beta$ -diphenylacrylate compound or (b) a diester or polyester of naphthalene dicarboxylic acid, but fails to teach the claimed combination of (a) and (b) and the claimed ratio of (a) to (b). The aforementioned declaration of Craig A. Bonda under 37 CFR 1.132 is sufficient to overcome the Bonda et al. '789 reference. Therefore, the instant claims are patentably distinct from the cited prior art.

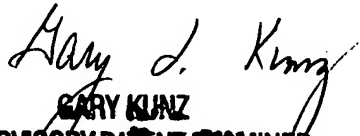
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Kunz, can be reached at (571) 272-0887.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
**GARY KUNZ**  
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ml  
1/4/05

